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REMARKS

Claims 1-36, 38-44, 46 and 47 are currently pending in the subject application and are presently under consideration. Claims 1, 7, 9-12, 17, 21-22, 25-27, 31-34, 36, 38-39, 41-44 and 47 have been amended. Claims 6, 8, 15, 20, 40 and 46 have been canceled. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

**L. Rejection of Claims 1-21, 44, 46 and 47 Under 35 U.S.C. §103(a)**

Claims 1-21, 44, 46 and 47 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Foley U.S. Patent No. 6,487,590 in view of Waldo U.S. Patent No. 6,449,648. Withdrawal of this rejection is respectfully requested for at least the following reason. Neither Foley nor Waldo, alone or in combination, teach or suggest all of the claim limitations. In addition, there is no teaching, suggestion, or motivation to combine the teachings of Foley with those of Waldo and the Examiner has not provided any *evidence in the prior art or other reference of record* to show otherwise. Thus, the Examiner has not established a *prima facie* case of obviousness and the cited references do not render obvious the subject matter as a whole.

The test of obviousness is whether "the subject matter sought to be patented and the prior art are such that the subject matter as a *whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art." (*Graham v. John Deere Co.*, 383 U.S. 1, 3 (1966) (emphasis added); see also e.g., *In re Dembiczkak*, 175 F.3d 994, 998, 50 U.S.P.Q. 1614, 1616 (Fed. Cir. 1999)). In evaluating obviousness, the PTO must conduct the factual inquiry as outlined in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). (See *In re Lee*, 277 F.3d 1338, 1342-43, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002)). The factual inquiry to be conducted includes determining: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. (See *Graham*, 383 U.S. 1, 17-18 (1966)). The PTO must "not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." (*In re Lee*, 277 F.3d at 1344, 61 U.S.P.Q.2d at 1434). The PTO cannot rely merely on conclusory statements and assertions of "common sense" to remedy deficiencies of the cited references. (*In re Lee*, 277 F.3d at 1344, 61 U.S.P.Q.2d at 1434). If the PTO relies on multiple prior art references as the basis for an obviousness rejection, it is not enough that all of the claim limitations appear in the prior art. To establish a *prima facie* case of

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obviousness, the PTO must also make an adequate showing of a suggestion, teaching, or motivation to combine the prior art references. (*See In re Dembiczaik*, 175 F.3d 994, 999-1001, 50 U.S.P.Q. 1614, 1617 (Fed. Cir. 1999) (citing to *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998)); *see also In re Lee*, 277 F.3d at 1343, 61 U.S.P.Q.2d at 1433). Only if the PTO establishes a *prima facie* case of obviousness does the burden of coming forward with evidence or argument shift to the applicant. (*See In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992)).

All of the subject claims recite the limitations a remote object (or an object reference base class) *decorated with customized (or customizable) attributes* and activating a *custom attribute* based process or similar limitations. Neither Foley nor Waldo, alone or in combination, teach or suggest this novel feature of the subject claims. The Examiner contends that Foley discloses process interception to activate a custom attribute based process at col. 5, lines 41-57. (*See* Office Action at p. 4). Applicants' representative respectfully disagrees. The cited sections of Foley merely disclose services that allow a client to view configuration information (viewConfig, notifyConfig, cancelNotify). These services do not disclose a custom attribute based process/code as recited in the subject claims. Moreover, Neither Foley nor Waldo, alone or in combination, teach or suggest a remote object or an object reference base class decorated with customized or customizable attributes as recited in the subject claims.

The Examiner contends that it would be obvious to combine the teachings of Foley with those of Waldo "because by employing a lease on the resource, the system would have control over the lifetime of the resource as disclosed in Waldo . . ." (Office Action at p. 3). However, the Examiner does not cite to *any evidence in the prior art or other reference of record* that would motivate, teach or suggest combining the teachings of Foley with those of Waldo. Instead, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art but, rather, suggested by the advantages disclosed in applicants' specification. This sort of approach has been repeatedly condemned by the Federal Circuit as entering the "tempting but forbidden zone of hindsight." (*In re Dembiczaik*, 175 F.3d at 998, 50 U.S.P.Q. at 1616 (citing to *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 873, 228 U.S.P.Q. 90, 98 (Fed. Cir. 1985), overruled on other grounds by *Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059, 46 U.S.P.Q.2d 1097 (Fed. Cir. 1998))). The Federal Circuit has warned against imbuing "one of ordinary skill in the art with knowledge of the invention in

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suit when *no prior art reference or references of record* convey or suggest knowledge," and falling "victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." (*In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (citing to *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)) (emphasis added); *see also In re Dembiczak*, 175 F.3d at 998-99, 50 U.S.P.Q. at 1616-17). As the Federal Circuit has stated:

Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. Combining prior art references *without evidence* of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. . . . [T]he showing must be *clear and particular*. *Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."*

(*In re Dembiczak*, 175 F.3d at 999, 50 U.S.P.Q. at 1617) (internal citations omitted) (emphasis added). The Examiner has not cited to any *prior art references or other references of record* that teach or suggest this purported motivation to combine. Indeed, all the Examiner has done is provided the "[b]road conclusory statements" that the Federal Circuit has held are not evidence that can support an obviousness rejection. (*In re Dembiczak*, 175 F.3d at 999, 50 U.S.P.Q. at 1617). In view of at least the foregoing, the subject claims are in condition for allowance and applicants' representative respectfully requests that this rejection be withdrawn.

## II. Rejection of Claims 22-29, 31-36 and 40-42 Under 35 U.S.C. §103(a)

Claims 22-29, 31-36 and 40-42 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Foley in view of Waldo, and further in view of Bainbridge U.S. Patent No. 6,014,700. Applicants' representative respectfully requests that this rejection be withdrawn for at least the following reasons. All of the subject claims recite the limitations a remote object (or an object reference base class) *decorated with customized (or customizable) attributes* and

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activating a *custom attribute* based process or similar limitations. As explained *supra*, neither Foley nor Waldo, alone or in combination, teach or suggest this novel feature of the subject claims. Bainbridge does not remedy this deficiency. As also explained *supra*, the Examiner has not provided any evidence in the prior art that would motivate, teach or suggest the combination of Foley with Waldo.

Moreover, the Examiner contends that it would be obvious to combine the teachings of Bainbridge with those of Foley "because by extending the object reference, a client request can be serviced directly by the specified server without going through a routing server as disclosed by Bainbridge." (Office Action at p. 7). However, the Examiner has not cited to anything *in the prior art or other reference of record* that would motivate, teach or suggest this combination as is required to establish a *prima facie* case of obviousness. In view of at least the foregoing, the subject claims are in condition for allowance and applicants' representative respectfully requests that this rejection be withdrawn.

### **III. Rejection of Claims 30, 38, 39 and 43 Under 35 U.S.C. §103(a)**

Claims 30, 38, 39 and 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Foley in view of Waldo, and Bainbridge, and further in view of King U.S. Patent No. 6,681,263. Applicants' representative respectfully requests that this rejection be withdrawn for at least the following reasons. Claims 30 and 38-39 depend from independent claims 22 and 32, which are allowable for the reasons stated *supra*. Claim 43 recites the limitations means for *customizing the derived object reference class* and means for selectively activating *custom attribute code* associated with a proxy. As explained *supra*, neither Foley nor Waldo nor Bainbridge, alone or in combination, teach or suggest this novel feature of the subject claims. King does not remedy this deficiency. As also explained *supra*, the Examiner has not provided any evidence in the prior art that would motivate, teach or suggest the combination of Foley with Waldo or Foley with Bainbridge. In view of at least the foregoing, the subject claims are in condition for allowance and applicants' representative respectfully requests that this rejection be withdrawn.

09/893,943MS174301.01/MSFTP252US**CONCLUSION**

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP252US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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